

REMARKS

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing Amendment, claims 1-23 are pending in the Application, with claims 1-5, 10, and 17-23 withdrawn from consideration by the Examiner as being drawn to non-elected inventions. The Amendment accompanying this response is believed to introduce no new matter and its entry is respectfully requested. Based on the above Amendment and the following remarks, applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn. Support for the Amendment to claim 6 is found in page 10, lines 11-12, and page 7, line 9, and throughout the specification. Support for the Amendment to claim 11 is found in page 5, lines 8-21, and throughout the specification.

Applicants note with thanks entry of the amendment filed December 8, 2003.

***CLAIM OBJECTIONS***

Applicants note with thanks the Examiner's withdrawal of the objection to claims 9 and 11 made in paragraph 14 of the previous Office Action.

The Examiner has objected to claims 12-16 as being dependent from a rejected base claim, claim 11. Based on amendment and argument contained herein, Applicants maintain that base claim 11 is allowable. Applicants respectfully request that the objection be withdrawn and that claims 12-16 be allowed.

*REJECTIONS UNDER 35 U.S.C § 112, FIRST PARAGRAPH*

Applicants note with thanks withdrawal of the rejections of claims 11-16 based on 35 U.S.C. § 112, first paragraph.

The Examiner has rejected claims 6-8 and claim 11 under 35 U.S.C. § 112, first paragraph as containing subject matter that was allegedly not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention at the time it was filed.<sup>1</sup>

The Office Action states that claims 6, as amended, includes new matter. The Office Action states that specification does not provide support of a bacterial culture medium containing "heat sterilized raffinose." Claims 7 and 8 are rejected as dependent on claim 6. Applicants have amended claim 6 herewith and have cited support for amended claim 6 in the specification as originally filed. Applicants request that in light of these amendments the rejection of claims 6-8 based on 35 U.S.C. § 112, first paragraph, be withdrawn, and the claims allowed.

The Office Action states that claim 11, as amended, includes new matter. The Office Action states that there is no indication that applicants are in possession of the "mutant of a mutant" claimed in 11(f). In a separate rejection under 35 U.S.C. § 112, the Office Action states that the specification does not reasonably provide enablement for the mutants claimed in claim 11, part (f).

Applicants have amended claim 11 and provided references to portions of the specification as originally filed that support the amendment. Therefore, applicants request that

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<sup>1</sup> By telephone interaction on April 27, 2004 and April 28, 2004, the Examiner confirmed that paragraph 18 of the Office Action, which begins "Claims 6-8 are rejected . . . " is directed to claim 11.

the rejection of claim 11 under 35 U.S.C. § 112, first paragraph, directed to alleged inclusion of "new matter" in the amendments, be withdrawn and the claim allowed.

Applicants further submit that amendment of claim 11 has rendered the second rejection of claim 11 under 35 U.S.C. § 112, for alleged lack of enablement, moot. Applicants contend that one skilled in the art (at the time the application was filed), with the benefit of having read the disclosure of the application, would be able to use the process described in the examples to analyze "mutants of mutants" to find those displaying increased amino acid production over that of their parent mutant as set forth in amended claim 11. Furthermore, this analysis would require a minimum of experimentation.

In light of the amendments to claim 6 and claim 11, Applicants respectfully request that the rejection of claims 6-8 and 11 under 35 U.S.C. § 112, first paragraph be withdrawn and that the claims be allowed.

*REJECTIONS UNDER 35 U.S.C § 112, SECOND PARAGRAPH*

Applicants note with thanks the withdrawal of the rejections of claims 6-8 and 11 based on 35 U.S.C. § 112, second paragraph.

The Examiner has rejected claims 6-8 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. Particularly, the Office Action states that claim 6, as amended, is confusing because it is allegedly unclear how "bacterial culture medium containing at least about 1% heat sterilized raffinate" is different from "raffinate medium which has been heat-sterilized." The Office Action further questions where the "bacterial culture medium" contains at least 1% raffinate or any amount of raffinate. Claims 7 and 8 are also rejected as

allegedly indefinite because they depend either directly or indirectly from an allegedly indefinite base claim.

Applicants submit that the amendment to claim 6 has rendered this rejection moot. The Examiner's questions with respect to nature and amount of medium and raffinate are answered by the claim as it is written. Applicants request that the rejection of claims 6-8 be withdrawn and the claims allowed.

*REJECTIONS UNDER 35 U.S.C. § 102(b)*

Applicants note that the rejection maintained in paragraph 10 of the Office Action mailed September 24, 2003, is withdrawn and that a modified rejection has been made. In the modified rejection the Office Action states that, given the Examiner's interpretation of raffinate, claims 6-8 are anticipated by U.S. Patent No. 5,077,207, to Shijo *et al.* Applicants submit that the amendment of claim 6 included herein has rendered this interpretation invalid by precluding the definition of "raffinate" offered by the Examiner.

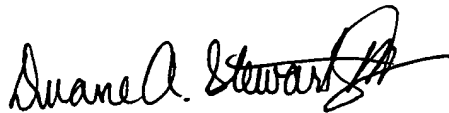
The Office Action also states that claims 6-8 are product-by-process claims, and that they are therefore not limited by the manipulations of the recited steps, but rather they are limited by the structure implied by the steps. As noted in Applicants' Response to the Office Action mailed September 24, 2003, the microorganisms of Shijo have not been selected to grow in a raffinate-containing medium as set forth in claim 6. There is no indication that they would display raffinate resistance, and no indication that they would have a structure similar to those microorganisms of the instant invention.

CONCLUSION

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and as such, the present Application is in condition for allowance. If the Examiner believes for any reason that personal communication will expedite prosecution of this Application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Duane A. Stewart III", with a stylized flourish at the end.

Dated: May 6, 2004

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